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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,829	10/29/2003	Al Brown	23662.00	2483
37833	7590	12/13/2004	EXAMINER	
LITMAN LAW OFFICES, LTD. P.O. BOX 15035 CRYSTAL CITY STATION ARLINGTON, VA 22215			SLACK, NAKO N	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,829

Applicant(s)

BROWN ET AL.

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction

In response to a restriction requirement, applicant has elected Group I, claims 1-13 with traverse. Though Applicant states that a reasonable example of "a material different process" has not been provided, the restriction stands for the following reason: the forming of a trim element with a core and outer shell may be achieved by various methods such as coextrusion, which is classified in various classes. While Applicant believes that such a search and examination would not pose a serious burden, forming methods are classified in various classes throughout the office, only one of which was cited in the restriction requirement.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of claim 12 must be shown or the feature(s) canceled from the claim(s). Specifically, a recess shorter than the core must be indicated in the drawings. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, one relief comprises a recess "shorter than said core". In what dimension and from what origin is this "shorter" measurement made? Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8-13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US Patent 6,481,170 to Savenok et al.

Claim 1:

Savenok et al. discloses a plant-on trim element (Figure 3) comprising an elongate, foraminous lath shell (14, Figure 3) defining a three-dimensional shape having an interior cavity; and an elongate core (12, Figure 3) having a shape closely conforming to the interior cavity of said lath shell installed within said lath shell, the core having at least one peripherally disposed relief (step formation) defined therein adjacent said lath shell.

Claim 2:

The plant-on element further includes a finish coating (16, Figure 3) applied to said foraminous lath shell, flowing therethrough and completely encapsulating said foraminous lath shell at each said relief of said core (column 3, lines 6-12).

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Claim 3:

The finish coating is formed of a cementitious material (column 3, line 8).

Claim 4:

The lath shell is formed of woven mesh (column 3, line 6).

Claim 8:

The lath shell shape and said core shape are selected from the group of shapes consisting of regular and irregular geometric shapes (Figure 5).

Claim 9:

The core is formed from materials selected from the group consisting of foam plastic (column 2, line 62).

Claim 10:

At least one relief has a cross sectional shape selected from the group of shapes consisting of regular and irregular geometric shapes (Figure 5).

Claim 11:

At least one relief extends length of said elongate core (Figure 5).

Claim 12:

At least one relief comprises a recess shorter than said core and formed in said core (Figure 5).

Claim 13:

Savenok et al. discloses a method of installing a plant-on trim element on an apparatus comprising the steps of:

(a) securing the lath and core assembly to the structure (column 3, lines 39-41)

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(b) applying a finish coating (column 3, lines 6-8) to the lath shell; and

(c) filling the at least one relief of the core with the

finish coating, thereby completely surrounding and encapsulating ("embed the mesh" column 3, line 7) the portion of the lath shell over the at least one relief.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,481,170 to Savenok et al. in view of US Patent 5,625,986 to Mansfield et al.

Claims 5-7:

While Savenok et al. does not disclose opposed flanges extending from the lath shell, such structure is well known in the art. For example, Mansfield et al. discloses a trim element comprising a perforated shell with outwardly extending flanges (35 and 36, Figure 2) for facilitating mounting of the shell to the substructure (column 4, lines 1-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to put flanges on Savenok et al.'s trim element, as Savenok et al. is concerned with facilitating securement of the molding to the building (column 2, lines 17-21).

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Regarding inwardly extending flanges, it would have been a matter of obvious design choice to one of ordinary skill in the art to form the shell flanges inwardly, as both outward and inward flanges would provide attachment faces for the substructure. Furthermore, applicant has not specified the criticality of orienting the flanges inwardly as opposed to outwardly.

Prior Art Cited of Interest

US Patent 6,802,163 to Hackman et al. discloses a plant-on trim with outwardly extending flanges.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


NS

December 8, 2004


Naoko Slack
Primary Examiner
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